REMARKS

In response to the Office Action mailed November 9, 2004, Applicants amend their application and request reconsideration. In this Amendment, claims 20 and 26 are cancelled leaving claims 1, 2, 7-9, 11-15, 17-19, 22-25, 27-33, and 35-43 pending.

At page 8 of the Office Action, the Examiner requested a new PTO-1449 form with regard to a previously filed Information Disclosure Statement. That substitute PTO-1449 form is attached.

The Present Amendment

In this Amendment, all of the independent claims are amended in a similar way. Essentially, claims 20 and 26 are incorporated into their respective parent claims 1 and 23 with some clarification. The other independent claims are amended in a way parallel to the amendments of claims 1 and 23. Obviously, the amendments find support in the application as filed based upon the prior examination of claims 20 and 26. In addition, support for the original disclosure is found within the patent application at pages 36-38 of the application as originally filed. Reference is made to the original specification here rather than to the substitute specification that has been filed. Attention is particularly directed to the original disclosure in the passages beginning at page 36, line 14, page 37 beginning at lines 20 and 29, and page 38 beginning at lines 10 and 24. Of course, the entire disclosure must be considered as a unit. These passages describe the game machine as including a read-only memory that stores a table of production patterns. The production patterns include combinations of word designs and each has an associated random number. A random number generator in the game machine produces random numbers that result in selection of production patterns that are combined to produce particular scenarios.

The Former Rejection

In the Office Action mailed November 9, 2004, claims 1, 2, 7-9 (erroneously listed as 5-9), 11, 18-20 and 23-32 were rejected as obvious over Ugawa (JP 9-56896) considered by itself. In addition, claims 12-15, 17, 21, 22, and 33-43 were rejected as obvious over Ugawa in view of Fuchs (U.S. Patent 5,630,753). These rejections are again respectfully traversed.

Although this response does not dwell on the previous rejections nor discuss them in detail with respect to each of the previously presented claims, the rejections are still respectfully traversed.

In the previous Amendment, language was added to each of the independent claims describing the combination of word designs as including exchanging of words between two

different characters in a display. The Examiner acknowledged that this description was not found in Ugawa and there was no assertion that it could be found in Fuchs. Rather, according to the rejection, "Ugawa teaches displaying a picture that performs the claimed function. The content of the picture is an aesthetic design choice." Office Action at page 3.

This response is insufficient to establish *prima facie* obviousness of the invention defined by the claims previously examined. If ever accepted, the U.S. Patent and Trademark Office has abandoned the "design choice" basis for establishing obviousness. This default basis for a rejection has been abandoned because it fails to meet the minimal legal requirements to establish *prima facie* obviousness. Even the MPEP makes clear that to establish *prima facie* obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP 2143 and 2143.03. Asserting that some missing elements of a claimed invention would have been an obvious variation of what is know in the art does not meet that requirement. Likewise, an assertion that the difference between what is shown in the art and what is claimed in an invention was "well within the ordinary skill of the art" is inadequate to establish *prima facie* obviousness. MPEP 2143.01. If the rejection is maintained in the original form or is maintained in a modified form, then Applicants require the Examiner to produce a prior art publication at least disclosing the limitations added in the previous amendment and acknowledged to be absent from Ugawa. Applicants intend to maintain the traversal of the previous rejection, regardless of any new, different, or modified rejection that may be made in view of the claims now presented, unless such a prior art publication is produced.

The New Claims

The new claims include novel limitations not disclosed or suggested by either of Ugawa or Fuchs. Therefore, an extended discussion of these claims in view of the former rejection is not necessary. Nevertheless, in view of the previous rejection of claims 20 and 26, claims now included in their respective parent claims, as obvious over Ugawa considered by itself, some discussion of the prior rejection with regard to the claims now presented is appropriate.

At page 4 of the Office Action mailed November 9, 2004, the Examiner, in rejecting claims 20 and 26, directed attention to Figures 5, 6, 10, and 17 of Ugawa, asserting that "Ugawa obviously has a memory for storing a production pattern determination table"... "and a random number generator". The Examiner had previously supplied a machine-generated translation of Ugawa because there is no English language counterpart of that publication. These translations are frequently almost beyond comprehension, as is the supplied translation. Nevertheless, an

attempt has been made to understand relevant parts of the disclosure of Ugawa, based upon the machine-generated translation, in order to respond to the former rejection of claims 20 and 26.

Applicants agree that numerous references are made to the use of random numbers in operation of the Ugawa pachinko game machine. Further, there are fixed display elements, apparently at at least three fixed location displays, in the Ugawa game. Apparently these fixed displays have a hexadecimal foundation or change characteristic. See the reference to display elements 1-9 and A-G. It is not clear from the English language translation of Ugawa whether there is an association of random numbers with each of these fixed location displays, as in the production pattern determination table that is now part of each of the claims pending in the patent application. It appears, however, that there is no such association. Rather each pattern at the various locations on the Ugawa display are subject to change in response to iterations of values that are apparently related to the production of random numbers. If the Examiner disagrees, he is asked to cite the specific paragraphs of Ugawa that allegedly support his position. As there is no clear disclosure in Ugawa on this issue, it would be inappropriate to make or repeat a rejection on this point unless a proper foundation for the rejection can be established.

Further, and even more importantly, there are no scenarios in Ugawa as in the invention. The scenarios are defined more clearly in the claims presented here as resulting from the combination of production patterns. While the Ugawa game generates various patterns of display elements, none of those combinations can be reasonably compared in any way to a scenario as in the invention. For the benefit of the prosecution, it must be borne in mind that the word "scenario" means "an outline of the plot of a dramatic or literary work". The invention as described in the patent application clearly involves the depicting and telling of a story, with numerous alternative events that may occur in various patterns depending upon the generation of random numbers, as described in the claims now presented. For example the tables of Figures 31-36, which were the focus of the early part of the prosecution of this patent application, disclose various story lines that can be combined. The combinations of events and the exchange of words between two different characters are parts of the development of events along various story lines. In addition, this scenario development is supported by Figures 2-8, 15, and 16, and the associated description. There is no counterpart of a scenario nor anything even like a scenario in Ugawa, further indicating the substantial difference between what is claimed in the present patent application and what is disclosed in Ugawa.

These differences demonstrate that no claim now pending can be obvious in view of Ugawa considered by itself.

Summary

For the reasons supplied above, the rejection in the Office Action mailed November 9, 2004, does not establish *prima facie* obviousness with regard to any claim pending as of the entry of the response filed July 15, 2004. In addition, the claims are amended further here, consistent with the original disclosure. These amended claims differentiate the invention still more clearly from Ugawa ,even if Ugawa is modified with Fuchs. Accordingly, reconsideration is requested, both with respect to the former claims and their final rejection and with respect to the claims now presented.

Favorable action is earnestly solicited.

Respectfully submitted,

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